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In re the Application of:

Leland James Wiesehuegel)

Serial Number: 09/714,726)

Group: 3624

Docket Number: AUS9-2000-0736-US1)

Examiner: Lalita M. Hamilton

Filed on: 11/16/2000)

For: "System and Method for Interactive)

Offer System")

APPEAL BRIEF

Real Party in Interest

The subject patent application is owned by International Business Machines Corporation of Armonk, NY.

Related Appeals and Interferences

None.

Status of Claims

On August 4, 2004, appellant appealed from the final rejections of claims 1 - 23.

Status of Amendments

Claims 1 - 3, 6 - 7, 9 - 15, 17, 22 - 23 were amended in a reply, dated 12/19/2003, to the first Office Action, dated 10/4/2003. Claims 1, 9, and 17 are independent claims. The claims are reproduced in the Appendix to this Appeal Brief.

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Summary of the Invention

Our invention prepares lists of items available from a supplier on which a bidder may place bids to purchase in a traditional style auction process. This list is prepared in advance of opening the auction or receiving any bids from the bidders or brokers. Our invention takes a complete list of *all* items being made available from a supplier (e.g. a full list of computer products available from IBM), and filters that list to produce a list of items on which a certain bidder is entitled to bid under contract (e.g. produce a list only containing hard drives for sale for a bidder or broker who has a contract only to sell IBM hard drives but not any other IBM computer products). This “entitled offering” is sent to each broker prior to opening the auction and prior to receipt of any bids for purchase from the bidders or brokers.

This allows an offeror (e.g. a manufacturer or supplier) to produce a master list, so to speak, which is all encompassing of all products and/or services which they would like to sell in through an auction. But, instead of showing each bidder in the auction the complete list of everything offered by that manufacturer or supplier, a tailored list of items is presented to each bidder according to contractual limitations between the offeror and the bidder. In this manner, each bidder is only allowed to see information regarding items to which they are entitled to bid, and not to any other items from the offeror.

This invention is designed to work in a “traditional” style auction, wherein the process is initiated by the offeror through the posting of one or more items for sale, followed by one or more bidders placing bids on those offered items, and then by selection of one or more “winning” bids to consummate an arrangement to sell the item(s) to the appropriate bidder.

Issues

Claims 1 - 23 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,085,169 to Walker, *et al.* (hereinafter “Walker”), in view of U.S. Patent 5,835,896 to Fisher, *et al.* (hereinafter “Fisher”).

In the previous Office Action in this application, claims 1 - 23 were rejected under 35 U.S.C. 102(a) over Walker, or alternatively under 35 U.S.C. §103(a) as being unpatentable over Walker as a sole reference.

Although the final Office Action is not specific as to the status of the initial rejections

under 102(a) or 103(a) over Walker alone, it is the understanding of the Appellant that these initial rejections were withdrawn after consideration of the reply to the first Office Action.

Therefore, Appellant believes that the rejections over Walker in view of Fisher are the remaining, standing rejections in the final Office Action.

In the final Office Action, it was stated that Walker teaches essentially all of our claimed steps, elements and limitations, except for presenting the “entitled offereings” to a bidder “prior to receiving any bids”. In the final Office Action, it was argued that Fisher teaches this missing step or element of our independent claims.

Appellant respectfully traverses these rejections as follows:

- (a) a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been properly established as no suggestion or motivation to modify Walker has been established;
- (b) no motivation or suggestion to make the proposed modification can exist as it would change a principle of operation of the primary reference, Walker;
- (c) no motivation or suggestion to make the proposed modification can exist as it would render the primary reference, Walker, undesirable for its intended purpose;
- (d) the proposed Walker-Fisher combination fails to teach all of our claimed steps, elements and limitations; and
- (e) no rationale was provided for the rejection of our dependent claims which specify additional steps, elements or limitations.

Grouping of Claims

Claims 1 - 23 stand or fall together.

The Examiner's Rationale

In the final Office Action, it was stated that:

Walker discloses the invention substantially as claimed; however Walker does not disclose the process of “subsequent to said preparation of entitled offerings but prior to receiving any bids to purchase any offered items, presenting via a computer user interface said entitled offerings to one or more prospective brokers such that each broker may review entitled offerings containing information regarding

items being offered for sale on which the broker is entitled to bid, but are not allowed to view information regarding items to which each broker is not entitled to bid." (pg. 2, last paragraph of final Office Action)

It was stated that Fisher teaches this missing step, element, with its limitations, at column 4 line 45, to col. 5 line 27, in the Fisher patent, which reads:

The present invention further provides, in a computer network enabling communication between a host computer and a plurality of remote customers, an auction information transmission and processing system implemented as a computer program within the host and network, comprising, a merchandise database connected in communication with the host for storing merchandise information, the merchandise information being descriptive of a lot available for purchase by a customer, a bid database in communication with the host for storing bid information, the bid information being descriptive of a bid received from one of the remote customers, an auction manager implemented in the server and in communication with the databases, an electronic mail messenger in communication with the auction manager and the bid database, a bid validator, including means for receiving bids from the customers, connected to the auction manager and in communication with the bid database, wherein the auction manager induces a customer to bid across the network on a lot of merchandise by posting a descriptive merchandise catalog page containing data from the merchandise database, the customer views across the network the catalog page and sends a bid to the bid validator across the network, the bid validator determines whether the bid is valid, the bid database stores the bid, the auction manager determines whether the bid is successful, and the electronic mail messenger notifies the customer whether the customer's bid was determined to be successful by the bid manager.

A primary advantage of this system is that it results in greater prices for merchants as well as broader distribution of their products. By incorporating an auction format which is available to a wide audience via electronic means, the inventive system and method results in more bidders, greater demand, and hence higher prices for the seller. And because this electronic system reaches a geographically diverse

audience, merchants' product lines becomes visible in areas where their products are not normally distributed or advertised, resulting in increased sales volume without increased marketing expense. As the network grows, business grows. Furthermore, the electronic auction system is automatic and does not require a human auctioneer, thereby allowing many individual items to be auctioned during the same time period and providing a decrease in costs associated with running an auction. Indeed, it would not be possible to operate an equivalent twenty-four hour per day, seven day per week auction with potentially hundreds or even thousands of individual items and millions of potential bidders without such an inventive electronic auction method and system. (Fisher, col 4 line 45 - col. 5 line 27)

It was stated in the final Office Action that:

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the process of presenting the offerings for review prior to receiving bids, as taught by Fisher into the process disclosed by Walker, as an additional rule that may be submitted by the customer when attempting to purchase an item, so that the customer may improve their chances of purchasing the exact item desired." (Page 3, first paragraph of the final Office Action)

No further rationale was provided, especially with respect to the rejection of the dependent claims, 2 - 8, 10 - 16, and 18 - 23, which specify additional limitations, steps and/or elements.

Arguments

We propose that errors cumulative to the improper final rejection under 35 U.S.C. §103(a) of independent claims 1, 9, and 17, as well as rejection of all dependent claims, include:

- (a) a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been properly established as no suggestion or motivation to modify Walker has been established;
- (b) no motivation or suggestion to make the proposed modification can exist as it would change a principle of operation of the primary reference, Walker;
- (c) no motivation or suggestion to make the proposed modification can exist as it would render the primary reference, Walker, undesirable for its intended purpose;
- (d) the proposed Walker-Fisher combination fails to teach all of our claimed steps, elements and limitations; and
- (e) failing to provide rationale for the rejection of our dependent claims which specify additional steps, elements or limitations.

(A) *Improperly Formed *prima facie* Case of Obviousness Without Suggestion or Motivation to Modify Primary Reference*

As evidenced by the quotation from the final Office Action, there has been no citation as to where within the Walker reference the motivation or suggestion “as an additional rule that may be submitted by the customer when attempting to purchase an item, so that the customer may improve their chances of purchasing the exact item desired” appears.

Walker discusses use of a “CPO”, or “conditional purchase offer”, which is a type of bid placed by a bidder. Walker clearly states that their CPO “rules” are:

A CPO rule is a set of restrictions defined by a given seller, such as an airline, to define a combination of restrictions for which the seller is willing to accept a predefined price. (Walker Abstract, emphasis added)

A CPO rule is a set of restrictions defined by a given seller, such as an airline, to define a combination of restrictions for which the seller is willing to accept a predefined price. The CPO rules are utilized by the CPO management system to render a decision to either accept, reject or counter a CPO on behalf of a particular seller. (Walker col. 2, lines 46 - 49, emphasis added)

Clearly, as used in the Walker disclosure, their “rules” are used to make an accept/reject decision, and are not related to preparing the lists of items which are to be offered to a specific prospective bidder in order to tailor the list to represent only items for which the bidder is contractually allowed to bid.

Possibly, the examiner was referring not to Walker's CPO “rules”, but to the CPO “conditions” or “parameters”, which are:

As used herein, a CPO is a binding offer containing one or more conditions submitted by a customer 110 for the purchase of an item, such as air travel, at a customer-defined price. In the illustrative airline embodiment, the customer-defined conditions would include itinerary parameters, such as the origin and destination cities; acceptable dates and times of departure and return; and whether connecting flights or stopovers are acceptable to the customer. In addition, the parameters of a CPO may allow a customer to specify one or more preferred airline(s), flights, seat assignments, seat class, aircraft type, refund/change rules, or maximum layover time. (Walker col. 5, lines 31 - 42, emphasis added)

However, Walker is silent as to their customer-defined conditions possibly including anything related to preparing a list of items for bid based upon a contractual arrangement or broker entitlement schema, or the desirability or motivation to modify their “conditions” to include such limitations.

In establishing the *prima facie* case of obviousness under 35 U.S.C. 103(a), it is the examiner's burden to point out where in the primary reference that motivation or suggestion to modify the primary reference as proposed is found. The motivation provided in the final Office

Action does not appear verbatim in the Walker disclosure, and it is not possible to correlate it to alternate text as no column-line number reference was provided either. The Court has established that the Examiner

...must state clearly and specifically an objections (the *prima facie* case) to patentability, and give the applicant fair opportunity to meet those objections with the evidence and argument". *In re Oeticker*, 977 F.2d 1443, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring)

Therefore, Appellant requests the final rejections of Claims 1 - 23 be withdrawn by the examiner, or be reversed by the Board, for failure to properly establish motivation or suggestion to make the proposed modifications to the primary reference.

(B & C) No Motivation or Suggestion to Make the Proposed Modification Can Exist Where The Proposed Modification Would Change a Principle of Operation of the Primary Reference and Would Render the Primary Reference Unsatisfactory For Its Intended Purpose

It has been established by the Court that no motivation to modify a primary reference can be found if (a) the proposed modification would render the primary reference unsuitable for its desired purpose, or if (b) it changes a principle of operation of the primary reference:

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

And:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to

render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), also cited at MPEP §2143.01

The Walker patent discloses specific methods and techniques related to what is now called “reverse auctions”, as opposed to “traditional auctions”. Well-known reverse auctions include PriceLine.com. Primary differences between the two types of auction are who initiates the process, and how many offerors or bidders are involved in the arrangement. The latter determines who has the “bargaining” leverage in the arrangement.

In a *traditional* auction, the “offeror” or seller initiates the process by posting a list of items available for purchase, and multiple bidders subsequently post bids or offers to purchase those items. This typically generates a one-offeror-to-many-bidders relationship. Bidders are not allowed to submit bids before the list of available items is posted (e.g. before the auction opens).

In a *reverse* auction, however, the process is initiated by a bidder, not by an offeror, and the first step is the bidder posting a offer *to purchase* (not and offer *to sell*) an item or service at a certain price. Often times, this offer to purchase is submitted to multiple suppliers, such as a Priceline.com bid to fly from Dallas to San Francisco next week on any airline willing to sell the ticket for \$120 or less. This offer has several conditions set by the bidder:

- (a) the flight must originate in Dallas;
- (b) the flight must terminate in San Francisco;
- (c) the flight must occur next week; and
- (d) the fare must be \$120 (or less).

This conditional bid is then submitted to at least one, and often times more than one, potential supplier (e.g. to multiple airlines). Any supplier wishing to sell their product or service under those conditions can accept the bid. In this arrangement, the airlines never posted such a flight as being available, because the process was initiated by the bidder, not by the offeror. Additionally, it usually creates a one-bidder-to-many-suppliers relationship, which is the opposite of the one-supplier-to-many-bidders relationship created in a traditional auction.

The Walker patent addresses certain needs for such *reverse* auctions, as indicated by Walker’s recitation of a “need in the art” (col. 2, line 25, “A further need exists for a buyer-driven system ...”), and throughout the disclosure in which the process is described as starting

with a bidder placing an offer to purchase (e.g. Walker's CPO offer) without the mention of any lists of available items from suppliers being provided first. Walker's examples all pertain to a bidder defining parameters such as desired flight dates, origination cities and a destination cities, times, etc., non-specific to any actual flights. These bidder-desired criteria (e.g. buyer-defined parameters) are then used to determine whether or not any actual available items (e.g. flights) meet these criteria from a number of potential suppliers. Clearly, the buyer initiates the process and the sellers never post a list of available items under the Walker process. This interpretation is also consistent with the well-known PriceLine.com business model, who is the assignee of the Walker patent.

Our invention relates to a seller-driven system in which the offeror or seller defines the conditions of sale of items or services, such as a traditional auction. Our system tailors the offers for sale (e.g. the lists of items for bidding) by each entitlement schema for each potential bidder prior to showing the list to the bidders. Our claims clearly stipulate that the process is initiated by the seller, not the bidder, and that unsolicited bids are not received from the bidder prior to the seller presenting the tailored lists of items for sale to the bidder.

To modify Walker as proposed to operate generally as a traditional auction instead of as a reverse auction would render Walker unsatisfactory for its intended purpose, and would change a principle of operation of the primary reference. As such, no motivation to make the proposed changes can exist.

Therefore, Appellant requests the final rejections of Claims 1 - 23 be withdrawn by the examiner, or be reversed by the Board, because no motivation to make the proposed change can exist when the proposed change would: (a) change a principle of operation of the Walker invention, or (b) render the Walker system unsatisfactory for its intended purpose.

(D) The Proposed Walker-fisher Combination Fails to Teach All of Our Claimed Steps, Elements and Limitations

Neither Walker nor Fisher teach our use of "entitlement schema" to produce a list of available items from an offeror, prior to receiving a bid from a bidder, and prior to presenting a list of available items to prospective bidders, wherein the entitlement schema is controlled by a contractual relationship regarding items on which each bidder is entitled to bid or not to bid.

Walker, as previously discussed, receives bids from bidders *before* posting available items for sale as it applies to reverse auction processes. Fisher makes no mention of entitlement schema, or of contracts (e.g. the term "contract" does not appear in Fisher).

The Court has established that all elements, steps, or limitations of the claims must be taught or suggested in order to form a proper basis for rejections:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Therefore, Appellant requests the final rejections of Claims 1 - 23 be withdrawn by the examiner, or be reversed by the Board, because the proposed combination fails to teach all of the claimed elements, steps, and limitations.

(E) Our Dependent Claims Are Allowable - No Rationale for the Rejection of Our Dependent Claims Which Specify Additional Steps, Elements or Limitations; and Inherent Allowability in View of Allowability of Claims From Which They Depend

As discussed regarding *In re Oeticker*, it is the initial burden of the Examiner to provide clear rationale for the rejection of all claims, including the dependent claims. In the final Office Action, rationale for rejection of claims 1 - 23 only addressed the steps, elements and limitations as claimed in our independent claims. It is not clear from the final Office Action what rationale is applied to the dependent claims 2 - 8, 10 - 16, and 18 - 23. Possibly the rationale of the first Office Action is maintained, although it is not specifically stated whether or not the rejections of the first Office Action were withdrawn or not.

Additionally, the Court has established that if independent claims are allowable over the cited art, then the claims which depend from those independent claims are also allowable:

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

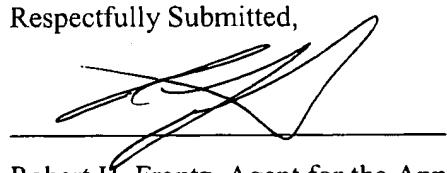
In view of the foregoing reasons regarding our independent claims being patentably distinct from the proposed Walker-Fisher combination, our remaining dependent claims 2 - 8, 10 - 16, and 18 - 23 are also patentably distinct.

Therefore, Appellant requests the final rejections of Claims 2 - 8, 10 - 16, and 18 - 23 be withdrawn by the examiner, or be reversed by the Board, because the rationale of their rejection has not been clearly stated, and the independent claims from which they depend are patentable over the cited art.

Summary

For the foregoing reasons, Appellant requests the final rejections of Claims 1 - 23 be withdrawn or reversed.

Respectfully Submitted,



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Appendix

Clean Form of Amended Claims

Claim 1:

A method for preparing and presenting entitled offerings to prospective brokers, said prospective brokers including buyers and bidders, and for collecting bids from said prospective buyers, bidders and brokers in response to said offerings, said method comprising the steps of:

establishing one or more broker entitlement schema in an offering and bid collection system, said broker entitlement schema being based on a contractual arrangement between one or more brokers, one or more traders, and manufacturer or service provider; each broker entitlement schema containing one or more entitlement definitions indicating contractually allowable items which may be offered for sale to each broker by said trader;

transmitting a first list of available items offered for sale by said manufacturer or service provider from said manufacturer or service supplier to a trader;

preparing one or more entitled offerings through filtering said first list of available items according to said broker entitlement schema such that said prepared entitled offerings include only information for one or more items to which a each broker is allowed to purchase as defined by each broker's associated broker entitlement schema; and

subsequent to said preparation of entitled offerings but prior to receiving any bids to purchase any offered items, presenting via a computer user interface said entitled

offerings to one or more prospective brokers such that each broker may review entitled offerings containing information regarding items being offered for sale on which the broker is entitled to bid, but are not allowed to view information regarding items to which each broker is not entitled to purchase.

Claim 2:

The method as set forth in Claim 1 wherein said step of providing a broker entitlement profile with entitlement definitions comprises providing an item category parameter within said entitlement definitions.

Claim 3:

The method as set forth in Claim 1 wherein said step of providing a broker entitlement profile with entitlement definitions comprises providing a broker location parameter within said entitlement definitions.

Claim 4:

The method as set forth in Claim 2 wherein said step of preparing one or more entitled offerings comprises removing items from said available items list which are unmatched by a category parameter within a broker entitlement definition to produce a minimized list of items for which a broker is entitled to receive offerings.

Claim 5:

The method as set forth in Claim 3 wherein said step of preparing one or more entitled offers comprises removing items from said available items list which are unmatched by a broker location parameter within a broker entitlement definition to produce a minimized list of items for which a broker is entitled to receive offerings.

Claim 6:

The method as set forth in Claim 1 wherein said step of presenting via a computer user interface said entitled offerings to one or more brokers comprises presenting said entitled offerings via a web browser user interface.

Claim 7:

The method as set forth in Claim 1 further comprising the step of receiving one or more bids from said prospective brokers via a computer network subsequent to said step of presenting said entitled offerings to said brokers.

Claim 8:

The method as set forth in Claim 7 wherein the step of receiving one or more bids comprises receiving bids via a computer network from a web browser system.

Claim 9:

A computer-readable medium containing computer executable program code for preparing and presenting entitled offerings to prospective brokers, said prospective brokers including buyers and bidders, and for collecting bids from said prospective buyers and brokers in response to said entitled offerings in a computer network server, said computer program code causing said computer network server to perform the steps of:

transmitting from a manufacturer or service provider to a trader a first list of items available for purchase from said manufacturer or service provider;

accessing at least one broker entitlement schema in a computer-readable record for one or more brokers, each broker entitlement schema containing one or more entitlement definitions indicating allowable items for which a broker may receive offers for items to purchase from said manufacturer or service provider according to a contractual agreement;

preparing one or more entitled offerings through filtering said first list of items against said broker entitlement schema such that each resulting entitled offering only includes items for which each broker is allowed to receive offers to purchase, and excludes information regarding items to which each broker is not entitled to purchase, as defined by the prospective broker's entitlement definitions; and

subsequent to said step of preparing entitled offers but prior to receipt of any bids from said brokers to purchase said available items, presenting via a computer user interface said entitled offerings to one or more brokers such that each broker may review lists containing only items available for purchase from said manufacturer or services on which the broker is entitled to bid.

Claim 10:

The computer-readable medium as set forth in Claim 9 wherein said program code for accessing a broker entitlement schema with entitlement definitions comprises computer program code for providing an item category parameter within said entitlement definitions.

Claim 11:

The computer-readable medium as set forth in Claim 9 wherein said program code for accessing a broker profile with entitlement definitions comprises program code for providing a broker location parameter within said entitlement definitions.

Claim 12:

The computer-readable medium as set forth in Claim 10 wherein said program code for preparing one or more entitled offerings comprises program code for removing items from said first items list which are unmatched by a category parameter within a broker entitlement definition to produce a minimized list of items for which a broker is entitled to receive offerings.

Claim 13:

The computer-readable medium as set forth in Claim 11 wherein said program code for preparing one or more entitled offerings comprises program code for removing items from said first items list which are unmatched by a broker location parameter within a broker entitlement definition to produce a minimized list of items for which a broker is entitled to receive offerings.

Claim 14:

The computer-readable medium as set forth in Claim 9 wherein said program code for presenting via a computer user interface said entitled offerings to one or more brokers comprises program code for presenting said entitled offerings via a web browser user interface.

Claim 15:

The computer-readable medium as set forth in Claim 9 further comprising program code for receiving one or more bids from said prospective brokers via a computer network subsequent to said step of presenting said entitled offerings.

Claim 16:

The computer-readable medium as set forth in Claim 15 wherein said program code for receiving one or more bids comprises program code for receiving bids via a computer network from a web browser system.

Claim 17:

An offering system in a computer network for preparing and presenting entitled offerings to brokers, buyers and bidders, hereinafter collectively referred to as "brokers", said computer network enabling communications between said offering system and broker consoles, said offering system comprising:

a database containing one or more broker entitlement schema, each broker entitlement schema containing entitlement definitions according to a contractual relations between a manufacturer or service provider and a broker regarding items to which the broker is entitled to receive offers for purchase, said database accessible and queriable by network application servers;

an entitled offering preparation server for preparing entitled offerings through filtering lists of available items against broker entitlement definitions to produce entitled offerings including only items to which a broker is entitled to bid and excluding items to which a broker is not entitled to bid, and for storing entitled sales offerings in said database; and

a network application server for providing said entitled offerings to broker console computers, said providing of entitled offerings being performed subsequent to preparation of the entitled offerings but prior to receipt of a bid from said broker.

Claim 18:

The offering system as set forth in Claim 17 wherein said network application server is an Internet server.

Claim 19:

The offering system as set forth in Claim 17 wherein said network application server is a Hyper Text Transfer Protocol (HTTP) server.

Claim 20:

The offering system as set forth in Claim 17 wherein said network application server is a secure Hyper Text Transfer Protocol (HTTPS) server.

Claim 21:

The offering system as set forth in Claim 17 wherein said network application server is adapted for communications with broker console computers which are web browser devices.

Claim 22:

The offering system as set forth in Claim 17 wherein said entitled sales offering preparation server is adapted to filter lists of available items by broker entitlement definitions including a broker location parameter.

Claim 23:

The offering system as set forth in Claim 17 wherein said entitled sales offering preparation server is adapted to filter lists of available items by broker entitlement definitions including an item category parameter.